

REMARKS

Claims 1 and 3-17 are pending.

Applicants' Response to the Claim Rejections under 35 U.S.C. §112

Claims 1 and 3-17 are rejected under 35 U.S.C. §112, first paragraph, on the basis that the specification does not specifically teach that the silica particles are nonconductive.

In regard to the submission of the reference materially submitted with the last amendment which discloses the known resistivity of a silica fine particle, the Examiner asserts that since the article was only submitted as part of the response, it is considered as argument of counsel which technically under U.S. patent law cannot take the place of fact. Rather evidence such as that submitted from the Japanese document must be submitted in a signed declaration under 37 CFR §1.132. The Office Action maintains that if applicants submit a declaration disclosing the resistivity of the silica particle used by the applicant, then that resistivity may be recited in the pending claims.

In support of this position, applicant submits herewith the Declaration of Hiroshi Nakatani under 37 C.F.R. §1.132. As detailed therein, it is common general knowledge within the art that silicon oxide is a nonconductive material. A skilled artisan in light of the general knowledge and the specific disclosures within the specification contrasting the silica fine particle (A) to the second silica fine particle (B) and the conductive inorganic fine particle (C) readily knows that the silica fine particle is nonconductive.

Application No. 10/570,151
Art Unit: 1795

Response under 37 C.F.R. §1.111
Attorney Docket No. 071850

In view of the above remarks and the attached Declaration of Hiroshi Nakatani, applicant submits that the claims are in condition for allowance. Applicant requests such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicant's undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicant respectfully petitions for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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Enclosure: Declaration under 37 C.F.R. §1.132